

IN THE DRAWINGS

The attached sheet of drawings includes changes to Fig. 8. This sheet, which includes Figs. 8, replaces the original sheet including Fig. 8.

Attachment: Replacement Sheet

REMARKS/ARGUMENTS

Favorable consideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-15 are pending in the application. The drawings are amended only to correct a minor informality cited in the outstanding Official Action, as discussed below. No new matter is added.

In the outstanding Official Action, the drawings were objected to because of a minor informality; Claims 1-6, 8-13 and 15 were rejected under 35 U.S.C. § 103(a) as unpatentable over Evanitsky et al. (U.S. Patent No. 5,045,880, hereinafter “Evanitsky”) in view of Streefkerk et al. (U.S. Patent No. 6,107,470, hereinafter “Streefkerk”); and Claims 7 and 14 were rejected under 35 U.S.C. § 103(a) as unpatentable over Evanitsky in view of Streefkerk and in further view of Fitzpatrick et al. (U.S. Patent No. 5,608,860, hereinafter “Fitzpatrick”).

This amendment is submitted in accordance with 37 C.F.R. § 1.116 which after final rejection permits entry of amendments canceling claims, complying with any requirement of form expressly set forth in a previous Official Action, and/or presenting rejected claims in better form for consideration on appeal. The present Amendment complies with the requirement of form expressly set forth in the previous Official Action by correcting a minor informality in Fig. 8, which is clearly supported at p. 15, lines 5-8 of the specification, as noted at p. 3 of the outstanding Official Action. No new matter has been added, and this amendment does not raise new issues requiring further consideration. It is therefore respectfully requested that the present amendment be entered under 37 C.F.R. § 1.116.

In the Official Action, the drawings were objected to because “they fail to show the ‘sidewise’ radio button selected in document orientation selection area a2 in Fig. 8 as described in the specification”, citing the specification at p. 15, lines 5-8. In response, Fig. 8

is amended so that the “document orientation” box (a2) indicates that the “sidewise” radio box is selected.

Accordingly, Applicants respectfully request that the objection to the drawings be withdrawn.

The outstanding Official Action rejected Claims 1-6, 8-13 and 15 under 35 U.S.C. § 103(a) as unpatentable over Evanitsky in view of Streefkerk. The outstanding Official Action cites Evanitsky as disclosing all the features recited in pending independent Claims 1, 8, and 15 with the exception of “wherein each symbol is graphically customized to display a first plurality of printing functions.” In an attempt to cure this deficiency the outstanding Official Action relies on Streefkerk as disclosing this claimed feature and states that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references and arrive at Applicants’ claims. Applicants respectfully traverse this rejection as there is no motivation or suggestion to combine the Evanitsky and Streefkerk references cited in the outstanding Official Action.

Independent Claim 1 relates to an image information processing device including a display unit configured to display at least one display screen including a symbol display area. A list of symbols is displayed in the symbol display area, *each symbol graphically customized to display a first plurality of printing functions*. A symbol from the list may then be selected by a selection unit, and a printing function setting unit sets a plurality of printing functions represented by the symbol selected.

The for a *prima facie* case of obviousness are (1) there must be some suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art reference must teach or suggest all the claimed features. It is respectfully submitted that the outstanding Official

Action fails to make a *prima facie* case of obviousness, because there is no suggestion or motivation to combine the cited references.

Turning to the applied references, Evanitsky describes a technique for preprogramming a reproduction machine for a plurality of complex jobs involving a variety of machine features and requirements. Specifically, when the machine is in operation, touching a "program head" file on the screen, displays a plurality of pre-programming slots or folders.<sup>1</sup> By touching one of the pre-programming folders, a job can be pre-programmed into that slot or folder using file folders and subfolders to simulate a plurality of features and sub-features of the machine.<sup>2</sup>

Streefkerk, the secondary reference, describes a printer display system that provides a visual representation (500), which is adapted according to the selection of specific document-finishing operations.<sup>3</sup> A selection of a document-finishing operation is effected by activating (e.g., clicking on) a specific selection area in the visual representation (500), for example, to select a stapling operation, a selection area around and including the picture of a staple (501) is indicated with a suitable place indicator (e.g., symbol representing a staple).<sup>4</sup> Thus, Streefkerk describes a process of selecting various printing functions by clicking on the visual representation (500), which customizes the settings for a single print operation.

Applicants respectfully traverse the obviousness rejection based on Evanitsky, and Streefkerk because there is insufficient evidence for a motivation to modify Evanitsky's system of assigning print functions to various pre-programming files by incorporating Streefkerk's selectable graphic interface for single use printing functions, for the following reasons.<sup>5</sup>

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<sup>1</sup> Evanitsky, Abstract.

<sup>2</sup> Id.

<sup>3</sup> Streefkerk, col. 4, lines 40-44.

<sup>4</sup> Id., col. 4, lines 51-59.

<sup>5</sup> See MPEP 2143.01 stating "[o]bviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art," (citations omitted). See also MPEP 2144.08 III stating that "[e]xplicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection.

The outstanding Official Action states that the proposed modification would have been obvious "to make choosing from many printing functions more convenient, easier and effective for the user."<sup>6</sup> The record, however, fails to provide the required evidence of a motivation for a person of ordinary skill in the art to perform such a modification. While Streefkerk provides a reason for using a visual representation of a printed page to select printing functions, the reference fails to teach or suggest why a person of ordinary skill in the art would be motivated to incorporate such a feature in the pre-programming system described by Evanitsky. In particular, Streefkerk uses the visual representation (500) to allow a user to click on an area of the visual representation to set print/copy features such as stapling, double sided printing and color printing for a single print job. Streefkerk, however, does not suggest that such a method of selecting printing options would work in the pre-programming system of Evanitsky, much less make choosing from various printer settings "more convenient, easier and effective for the user," in such a pre-programming system. Specifically, Evanitsky already depicts a user interface (270) which graphically displays a plurality of print functions, which users are able to select and place into each of the pre-programming folders (580-0...) for subsequent selection.

In addition, Evanitsky is not concerned with making the process of choosing from many printing functions more convenient and effective for a user. Evanitsky states that a structure already achieves the goal of providing an interface (270), which allows a user to select various print functions that are pre-programmed and stored into various folders, as depicted at Fig. 13 and described at col. 3, lines 39-58. Evanitsky does not suggest that further improvement is desired, or that another feature should be added to further improve the process of selecting printing functions from the plurality of printing functions. In particular, Evanitsky does not suggest to add an additional visually represented interface that changes

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... Conclusory statements of similarity or motivation, without any articulated rational or evidentiary support, do not constitute sufficient factual findings."

<sup>6</sup> Outstanding Official Action, p. 5.

based on selections made by a user for a single printing operation, such as the system described in Streefkerk.

As discussed above, Streefkerk describes that a user clicks on various portions of the visual representation (500), which then automatically causes print functions to be set in the printer. Evanitsky already describes a similar interface (270) allowing a user to select various print functions that are then stored in the pre-programming folders. Further, Streefkerk fails to teach or suggest that the modified visual representation (500) may be stored and used for subsequent print jobs, whatsoever, but is instead only used for the selection of current settings for the printer. Thus, one of ordinary skill in the art at the time of the invention would clearly not be motivated to add Streefkerk's visual representation to Evanitsky's system to "to make choosing from many printing functions more convenient, easier and effective for the user" because Evanitsky's system already includes a simplified icon-based interface.

The Evanitsky and Streefkerk patents, therefore, do not provide the motivation to perform the proposed modification of Evanitsky. In other words, in an attempt to bring the isolated teachings of Streefkerk into Evanitsky would amount to improperly picking and choosing the features from different references without regard to the teachings of the references as a whole.<sup>7</sup> While the required evidence of motivation to combine may not come from the applied references themselves, the evidence must come from *somewhere* within the record.<sup>8</sup> In this case, the record fails to support the proposed modification of Evanitsky's system.

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<sup>7</sup> See In re Ehrreich 590 F.2d 902, 200 USPQ 504 (CCPA, 1979) (stating that patentability must be addressed "in terms of what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the sum of all the relevant teachings in the art, not in view of first one and then another of the isolated teachings in the art," and that one "must consider the entirety of the disclosure made by the references, and avoid combining them indiscriminately.")

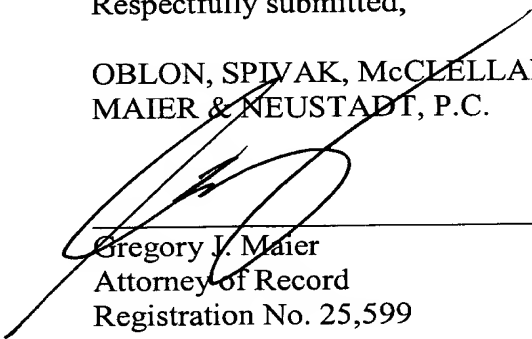
<sup>8</sup> In re Lee, 277 F.3d 1338, 1343-4, 61 USPQ2d 1430 (Fed. Cir. 2002) ("The factual inquiry whether to combine references ... must be based on objective evidence of record. ... [The] factual question of motivation ... cannot be resolved on subjective belief and unknown authority. ... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion").

In rejecting a claim under 35 U.S.C. § 103(a), the U.S. PTO must support its rejection by "substantial evidence" within the record, and by "clear and particular" evidence<sup>9</sup> of a suggestion, teaching, or motivation to combine the teachings of different references. As discussed above, there is no substantial evidence, nor clear and particular evidence, within the record of motivation for modifying Evanitsky by incorporating Streefkerk's system for selecting print options. Without such motivation and as an improper hindsight reconstruction, a person of ordinary skill in the art would not be motivated to perform the proposed modification, and Claims 1-15 are believed to be non-obvious and patentable over the applied references.

Consequently, in view of the present amendment and in light of the foregoing comments, it is respectfully submitted that the invention defined by Claims 1-15 is patentably distinguishing over the applied references. The present application is therefore believed to be in condition for formal allowance and an early and favorable reconsideration of the application is therefore requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



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Gregory J. Maier  
Attorney of Record  
Registration No. 25,599

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 06/04)

Andrew T. Harry  
Registration No. 56,959

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<sup>9</sup> In re Dembiczak, 175 F3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although 'the suggestion more often comes from the teachings of the pertinent references.' The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular." ) (emphasis added).